

REMARKS

In the Office Action dated August 19, 2009, claims 1, 2, 4, 6, 9, and 60-69 were rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over *Hoy et al.* (U.S. Patent No. 5,878,947). Upon entry of this Amendment, claims 70-77 will have been added, and claims 1-2, 4, 6, 9, and 60-77 will be pending in this application.

Response to Rejections Under 102 and 103:

In the First Office Action after RCE dated August 19, 2009, the Examiner cited 35 U.S.C. § 103(a) and then rejected all pending claims on an improper combination 102(b)/103(a) rejection. This format of rejection is improper as Applicants have not been apprised of the basis for the rejection of each claim. Applicants are unclear whether the Examiner is asserting that each claim is rejected as anticipated under 102(b) (with *Hoy* providing each element) or under 103(a) (with *Hoy* lacking certain elements that the Examiner believes are obvious to add). This failure of the Examiner to present specific rejections renders the First Office Action moot and will not enable a Second Office Action to be made final. Accordingly, Applicants request that the Examiner clarify the rejections in any subsequent action--separating the rejections into different sections (with 102 and 103 being separated even if based on the same reference) and specifying which elements the Examiner contends are anticipated by the cited reference for any anticipation rejection and which elements are obvious to add to the cited reference(s), with reasoning to establish a prima facie case of obviousness.

Additionally, if any rejections are based on *Hoy* alone, Applicants submit that *Hoy* fails to teach or suggest each and every element of each of the claims. For example, claims 1 and 64 recite that "the first portion being removable from the carton." *Hoy* cannot anticipate at least this element since the stop 56 of *Hoy* is formed from strips 58 and 60, which are provided to restrict

containers from rolling out of the carton. The stop 56 is not removable from the carton as claimed and therefore *Hoy* does not anticipate at least claims 1 and 64. Further, claim 67 provides a tear line arrangement that includes a first tear line and a second tear line in the third panel spaced a predetermined distance. *Hoy* fails to disclose the claimed tear line arrangement.

Further still, *Hoy* alone fails to render the claims obvious under 35 U.S.C. § 103 since *Hoy* fails to teach removal of the removable portion from the carton or the tear line arrangement claimed and fails to provide any motivation for making such modifications. In fact, modifying *Hoy* as proposed by the Examiner would render *Hoy* unsatisfactory for its intended purpose (contrary to MPEP 2144.03(V)) and would change the principle of operation of *Hoy* (contrary to MPEP 2144.03(VI)). Specifically, the stop 56 of *Hoy* is intended to “provide a stop outwardly of the package to more positively retain the cans until removed one at a time” (see column 1, lines 49-52 of *Hoy*). The stop 56 of *Hoy* cannot be removed from the carton as claimed without rendering *Hoy* unsatisfactory for its intended purpose of providing a dispensing feature with a retaining means to retain one can at a time (column 1, lines 53-62). According to MPEP 2143.01 (V), rendering the prior art unsatisfactory for its intended purpose fails to support a case for obviousness. Further, the modification of *Hoy* to remove the stop from *Hoy*’s carton would change the principle of operation of *Hoy*, since removing the stop from the *Hoy* carton would enable the cans therein to roll out of the carton without being retained on the porch--which is contrary to column 1, line 65 through column 2, line 6 of *Hoy*. Changing the principle of operation of a reference fails to support a prima facie case of obviousness--see MPEP 2144.03(VI). Thus, Applicants submit that rejections based on obviousness by *Hoy* can not be supported.

Additionally, the 35 U.S.C. § 103(a) rejections are based on a single reference, *Hoy*, and Applicants submit that the rejections do not present a prima facie case of obviousness as required under 706.07(1)(j). Not only do such rejections lack any indication of which claims the Examiner is rejecting under 35 U.S.C. § 103(a), as opposed to 35 U.S.C. § 102(b), it is unclear which elements of the claims the Examiner contends *Hoy* is missing, but that would nevertheless be obvious to combine into *Hoy*. The Applicants traverses the 103(a) rejections based on a single reference (whichever those claims happen to be), and shifts the burden to the Examiner to provide documentary evidence of any items the Examiner is relying on official notice to reject (see 2144.03(C)).

Claims 70-77 have been added by the present Amendment and also define over *Hoy*. For example, claims 70-71 recite that the second portion is hingeable along the first intersection line and the second intersection line. Claims 72-73 provide that the first side and the fourth side intersect at a fold line and wherein the first intersection line and the second intersection line are spaced from the fold line. Claim 74 recites that the first transverse cut and the second transverse cut are spaced from the fourth fold line and the fifth fold line. Claims 75-76 recite that the first portion is removable from the second portion. Claim 77 recites “a removable portion is defined by the first tear line, the second tear line, the third tear line, and the fourth tear line, and wherein the removable portion is detachable along the first tear line, the second tear line, the third tear line, and the fourth tear line.” *Hoy*, at best, shows hinging along the fold line between panel 16 and end flap 38, but does not teach or suggest hinging at the first intersection line and the second intersection line, does not teach or suggest hinging along transverse cuts that are spaced into a side or from a fold line, and does not teach or suggest that the first portion is removable from the

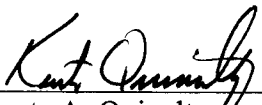
second portion as claimed. Accordingly, these newly added claims also define over *Hoy* and rejections based thereupon would lack support in *Hoy*.

The dependent claims recite additional elements that are not taught or shown by the cited references and are allowable on their own merits. Additionally, the dependent claims are allowable as being dependent upon allowable independent claims and inheriting such allowable characteristics thereof.

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 09-0528.

Respectfully submitted,

10/1/09
Date


Keats A. Quinalty
Registration No. 46,426

Customer No. 26158
WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
P.O. Box 7037
Atlanta, Georgia 30357-0037
(404) 879-2423 (telephone)
(404) 879-2923 (facsimile)